

Doc Code: AP.PRE.REQ

PTO/SB/SS (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)  
2305

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  
on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number  
10/644,513

Filed  
August 20, 2003

First Named Inventor  
Bryce A. Jones

Art Unit  
2618

Examiner  
Tuan Hoang Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 41,962

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

*Richard A. Machonkin*

Signature

Richard A. Machonkin

Typed or printed name

(312) 913-0001

Telephone number

October 17, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

American LegalNet, Inc.  
www.USCourtForms.com

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Docket No. 2305)**

<b>In the Application of:</b>	)	
	)	
<b>Jones, et al.</b>	)	<b>Art Unit: 2618</b>
	)	
<b>Serial No.: 10/644,513</b>	)	<b>Examiner: Nguyen, Tuan Hoang</b>
	)	
<b>Filed: August 20, 2003</b>	)	<b>Confirmation No. 6581</b>
	)	
<b>For: Virtual Visitor Location Register</b>	)	
<b>For A Wireless Local Area Network</b>	)	

**REASONS FOR REVIEW OF FINAL REJECTION**

Applicants request review of the final rejection mailed on July 24, 2008, because the Examiner has clearly erred in rejecting the claims.

**1. The Claimed Invention**

The claims currently under examination are claims 1, 3, 4, and 6-11 of which claim 1 is independent. Claim 1 is directed to a wireless local area network (WLAN) for providing telecommunications services to a multi-mode mobile station that is also able to wirelessly communicate with a wireless wide are network (WWAN) when operating in a first wireless coverage area. The WWAN includes a first data register, e.g., a home location register (HLR), that contains a first data record for the multi-mode mobile station. The WLAN comprises: (a) at least one access point providing a second wireless coverage area, wherein the multi-mode mobile station is able to wirelessly communicate with the at least one wireless access point when it operates in the second wireless coverage area; (b) a private branch exchange (PBX) communicatively coupled to

the at least one wireless access point; and (c) a second data register co-located with the PBX and communicatively coupled to the first data register, wherein the second data register stores a second data record for the multi-mode mobile station when it operates in the second wireless coverage area, the second data register being able to transmit at least one mobility management message to the first data register, wherein the at least one mobility management message facilitates roaming between the first and second wireless coverage areas by the multi-mode mobile station.

## **2. Status of the Claims**

Claims 1, 3, 4, and 6-9 stand rejected under § 103(a) as being unpatentable over Karaoguz et al., U.S. Pub. No. 2002/0059434 (“Karaoguz”) in view of Lu et al., U.S. Patent No. 6,694,134 (“Lu”). Claims 10 and 11 stand rejected under § 103(a) as being unpatentable over Karaoguz in view of Lu and Thornton et al., U.S. Pub. No. 2002/0101860 (“Thornton”).

## **3. The Examiner’s Clear Error**

The Examiner has admitted that Karaoguz does not teach the “second data register” recited in claim 1 and has instead relied on Lu for this element. *See* Final Office Action, pp. 4-5. In the Examiner’s rationale, the VLR/HLR described in col. 6 of Lu corresponds to the claimed “second data register.” *See* Final Office Action, pp. 2-3. In particular, the Examiner has argued that this VLR/HLR is (i) co-located with a PBX and (ii) transmits at least one mobility management message that facilitates roaming. However, the Examiner is wrong on both counts.

### **a. The VLR/HLR is not “co-located” with the PBX**

Claim 1 recites “a second data register *co-located* with said PBX.” The VLR/HLR that allegedly corresponds to the “second data register” is included in private cellular network 110, as described in col. 6, lines 18-24. Private cellular network 110, in turn, is included in private network

108. See col. 6, lines 15-17. Private network 108 also includes a private branch exchange (PBX)

118. See col. 6, lines 31-32. However, Lu does not teach that the VLR/HLR in private cellular network 110 is *co-located* with PBX 118. To the contrary, Lu makes clear that private cellular network 110 and PBX 118 are *separate* elements, as shown in Figure 1 and as described in col. 7, line 63 – col. 8, line 4.

In response, the Examiner has argued that the VLR/HLR must be co-located with the PBX because both the VLR/HLR and the PBX belong to private network 108. See Final Office Action, p. 2. That argument, however, makes no sense. The whole point of having a “network,” private or otherwise, is to enable devices in *different* locations to communicate with one another. For example, a central office switch in New York and a central office switch in Los Angeles may both be part of the public switched telephone network (PSTN), but that does not mean that these two switches are *co-located*. Therefore, the mere fact that the VLR/HLR and the PBX are both in private network 108, does not mean that the VLR/HLR is co-located with the PBX.

The Examiner has also argued that the VLR/HLR and the PBX are co-located because “they are in the same room, office, building...” See Final Office Action, p. 2. However, Lu does not disclose that the VLR/HLR and the PBX are in the same room, office, or building. Moreover, the mere fact that the VLR/HLR and the PBX belong to private network 108 does not mean that these elements would necessarily be in the same room, office, or building.

Because the Examiner’s argument that Lu’s VLR/HLR and PBX are co-located is unsupported by anything in Lu -- and is contradicted by Lu’s teachings that the VLR/HLR and the PBX are separate elements -- the Examiner’s claim rejections are clearly erroneous and should be withdrawn.

**b. The VLR/HLR does not transmit a mobility management message that facilitates roaming**

In addition to being co-located with the PBX, claim 1 recites “said second data register being able to transmit at least one mobility management message to said first data register, whereby said at least one mobility management message facilitates roaming between said first and second wireless coverage areas by said multi-mode mobile station.” The Examiner has argued that Lu discloses this element, specifically citing to col. 6, line 57 – col. 7, line 19. *See* Final Office Action, pp. 2-3. That argument, however, is fatally flawed because nothing in that section refers to the VLR/HLR, the “second data register” in the Examiner’s rationale. Thus, even if col. 6, line 57 – col. 7, line 19 of Lu could somehow be understood as referring to “at least one mobility management message,” nothing in Lu describes such messages as being transmitted by the VLR/HLR, the alleged “second data register.” To the contrary, that section of Lu describes the function of emulator program 130 running on device 122. Figure 1 of Lu makes clear that device 122 is a separate element from private cellular network 110, which is where the VLR/HLR (the alleged “second data register”) is located. Therefore, even if one were to consider the VLR/HLR to be a “second data register,” Lu still does not disclose “said second data register being able to transmit at least one mobility management message to said first data register,” as recited in claim 1.

In addition, the Examiner has glossed over the roaming function of the at least one mobility management message: “whereby said at least one mobility management message facilitates roaming between said first and second wireless coverage areas by said multi-mode mobile station.” According to the Examiner, the “mobility management message” is met by the function of device 122 simultaneously engaging in voice communication through a first communication path 138 (the

“first wireless coverage area” in the Examiner’s rationale) and data communication through a second communication path 140 (the “second wireless coverage area” in the Examiner’s rationale). *See* Final Office Action, p. 3. However, as shown in Figure 1 and described in col. 7, lines 8-12 of Lu, communication paths 138 and 140 originate from the *same* access point 114. Thus, the simultaneous communication described in Lu has nothing to do with a multi-mode mobile station roaming between first and second wireless coverage areas. Instead, Lu makes clear that device 122 simultaneously engages in voice and data communication while in one wireless coverage area, namely, the wireless coverage area provided by access point 114. Therefore, even if one were to regard the communications described in Lu as being “at least one mobility management message,” such communications still do not facilitate “roaming between said first and second wireless coverage areas by said multi-mode mobile station,” as recited in claim 1.

Because the Examiner has failed to show “at least one mobility management message” that is transmitted by a “second data register” and that “facilitates roaming,” as recited in claim 1, the Examiner’s claim rejections are clearly erroneous and should be withdrawn.

#### **4. Conclusion**

For the foregoing reasons, Applicants submit that the Examiner’s rejections of the pending claims are clearly erroneous and that all of the pending claims should be allowed.

Respectfully submitted,

Dated: October 17, 2008

By: Richard A. Machonkin  
Richard A. Machonkin  
Reg. No. 41,962